REMARKS

The Office Action mailed December 20, 2005 considered claims 1-31 and 35. Claims 1-7, 11-18, 21-29, 31 and 35, are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (U.S. 2002/0194307 A1) hereinafter "Anderson" in view of Oppenheimer et al (US 2003/0014477 A1) hereinafter "Oppenheimer". Claims 8, 9, 10, 19, 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Oppenheimer, and further in view of LaRue et al. (U.S. 6,535,892 B1) hereinafter "LaRue."[1]

By this paper claims 1, 11, 21, 23, 30 and 35 have been amended[2] and new claim 36 has been added such that claims 1-31 and 35- 36 remain pending, of which, claims 1, 11, 21, 23, 20, and 35 are the only independent claims at issue.

Claims 1 and 21 are method claims, which claim embodiments of applicants' invention from a client-side perspective, whereas claim 23 is directed to a similar method recited from the server-side perspective. Claims 11, 35, and 30 are computer program product claims which correspond to method claims 1, 21, and 23, respectively.

As presented herein for reconsideration, Applicants' claimed method and computer program product are adapted for use in a network environment that includes a client that is network connectable over a wireless network to a server so that the client may transmit document-inclusion operations that are intended to be carried out by the server, but wherein the wireless network may have limited throughput such that data transfer for document-inclusion operations may be unduly slow or costly. Applicants' claimed method and computer program product are designed to reduce those instances when the document-inclusion operation transmitted to the server actually requires transmission of a document that is required by the server to complete the requested operation, thereby reducing instances of unduly slow or costly data transmission when performing such document-inclusion operations over a wireless network.

As claimed for example in independent claim 1, the method includes *displaying to a user at the client an indication that the document is attached to a message even when the document is not attached to the message.* The method further includes sending from the client over the wireless network a document-inclusion instruction to the server, and wherein the document-

[1] Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

[2] Support for the amendments can be found throughout Applicants' specification, but with particularity at paragraph [0047].

inclusion instruction that is sent to the server does not include the document itself in the first instance. If the identified document is already stored at the server, the client's document-inclusion instruction is thus sufficient to permit the server to carry out the instruction so the client need take no further action in terms of sending the actual document to the server. On the other hand, if the identified document is not already stored at the server, then the client receives back from the server an indication that the document identified in the document-inclusion instruction is unavailable to the server. The client may then determine whether to send the identified document to the server over the wireless network to allow the server to execute the document-inclusion instruction using the document if sent by the client to the server or whether to simply wait and send the document later over a network that does not have the kind of limited throughput and bandwidth that the wireless network has.

Independent claim 23 claims the method in similar terms, except from a server-side perspective of the method. Claim 21 is directed to applicants' method and claims it from a client-side perspective similar to claim 1, except that independent claim 21 includes a functional step as a limitation (e.g. "a step for ensuring that a document-inclusion operation corresponding to the document-inclusion instruction is performed by the client if and only if the client is advised by the server that the identified document is not already stored at the server, so as to conserve the network bandwidth of the wireless network and to allow the server to execute the document-inclusion instruction using the document if the document inclusion operation is performed by the client.").

As noted previously, claims 1, 11, 21, and 35 have been amended to further clarify what is recited by the claims. In particular, these claims now recite *displaying to a user at the client an indication that the document is attached to a message even when the document is not attached to the message*"

This is in direct contrast to what is disclosed by *Anderson* and *Oppenheimer*. *Anderson* does not teach displaying to a user at the client an indication that the document is attached to a message even when the document is not attached to the message. Rather, *Anderson* teaches actually sending a document at a mobile device to a server for printing [0030] and retrieving or printing documents not at the mobile device [0036]-[0040]. However, *Anderson* fails to teach displaying to a user at the client an indication that the document is attached to a message *even when the document is not attached* to the message.

Applicants also submit that *Oppenheimer* fails to compensate for the deficiencies of *Anderson* in this regard. *Oppenheimer* illustrates a method of storing a file on a server. *Oppenheimer* states that "[i]f a copy of the file already exists on the server, the file need not be uploaded from the user's local file system." *Oppenheimer* at [0045]. However, "[i]f an identical file is not already stored on [the server], the file is suitably uploaded ...." However, Oppenheimer is silent as to embodiments including *displaying to a user at the client an indication that the document is attached to a message even when the document is not attached to the message*. As such, claims 1, 11, 21, and 35 are patentable over *Anderson* and/or *Oppenheimer* in light of the preceding.

Additionally with respect to all of the independent claims 1, 11, 21, 23, 30, and 35, Applicants respectfully traverse the Examiner's characterization of *Oppenheimer*. In particular, the Examiner states that "[a]lthough *Oppenheimer* does not explicitly state that the client determines whether to send the document to the server, rather merely states that the file is downloaded from the client one of ordinary skill in the art would find this feature obvious in order to conserve bandwidth on the user's network, thereby allowing more control over what the computer does and how it utilizes bandwidth (i.e. defer upload until a later time, when allowed by the user, etc.)." However, the Examiner is reminded that to sustain a *prima facia* obviousness rejection, "all the claim limitations must be taught or suggested by the prior art." MPEP 2143.03. By the Examiners own admission ("although Oppenheimer does not explicitly state...") *Oppenheimer* does not show the element of "whereupon, if it is determined by the client to send the document to the server, the server thereafter executes the document-inclusion instruction using the document sent by the client to the server." As such, the Examiner has failed to show each and every element recited by the claims of the present application. If the Examiner is relying on Official Notice to supply the missing elements, Applicants respectfully requests that the Examiner provide documentary support showing the asserted elements of the Official Notice at the time of the invention and the requisite motivation for combining the asserted teachings with the asserted teachings of the cited art, as Applicant respectfully disagrees with the Examiner's assertions with regard to the asserted teachings and motivation for their combination to reject the claims. *See* MPEP § 2144.03(C). Moreover, Applicants remind the Examiner that it is generally against accepted examination guidelines to finally reject a claim while relying on Official Notice. MPEP § 2144.03(A) ("While 'official notice' may be relied on, these circumstance should be rare when an application is under final rejection").

Additionally, Applicants point out the Examiners stated motivation is without logical support. In particular, the Examiner states that "one of ordinary skill in the art would find this feature obvious in order to conserve bandwidth on the user's network...." Applicants point out however that in the Examiner's described scenario, the deferral of transmitting does not conserve bandwidth at all. The document is still sent using the same amount of bandwidth, just at a different time.

Oppenheimer illustrates a method of storing a file on a server. *Oppenheimer* states that "[i]f a copy of the file already exists on the server, the file need not be uploaded from the user's local file system." *Oppenheimer* at [0045]. However, "[i]f an identical file is not already stored on [the server], the file is suitably uploaded ...." This, however, clearly does not teach or even suggest that the client thereafter determines whether to send the document to the server, and particularly, *whereupon, if it is determined by the client to send the document to the server, the server thereafter executes the document-inclusion instruction using the document sent by the client to the server.* Rather, *Oppenheimer* simply allows files to be stored for backup purposes or for remote file access. See *Oppenheimer* at [0045]. As such, claims 1, 11, 21, 23, 30, and 35, which each recite a limitation similar to that described above, are believed to be patentable over *Anderson* and/or *Oppenheimer* alone or in combination.

LaRue et al., U.S. Patent No. 6,535,892, which was cited only for showing determining version conflicts, also fails to compensate for the deficiencies of *Anderson* and *Oppenheimer* for at least failing to teach the limitations cited above.

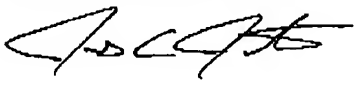
For at least the foregoing reasons, Applicants respectfully submit that *Anderson, Oppenheimer*, and *LaRue*, alone and in combination, do not teach or suggest what is recited by the claims of the present application.

Furthermore, although the foregoing remarks have been focused primarily on the independent claims, it will be appreciated that all of the rejections and assertions of record with respect to the independent claims, as well as the dependent claims, are now moot, and therefore need not be addressed individually. However, in this regard, it should be appreciated that Applicant does not necessarily acquiesce to any assertions in the previous Office Action that are not specifically addressed above, and hereby reserves the right to challenge those assertions at any appropriate time in the future, should it arise, including any official notice.

In the event of any further question that may be clarified by a teleconference, the Examiner is invited to initiate the same with the undersigned attorney of record.

Dated this 17 day of March, 2006.

Respectfully submitted,



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